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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/142,043 12/01/98 MOSSAKOWSKA D 88362/104

FOLEY & LARDNER
3000 K STREET N W
SUITE 500
WASHINGTON DC 20007-5109

HM12/0427

EXAMINER

HAMUD, F

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

04/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/142,043

Applicant

MOSSAKOWSKA et al.

Examiner
Fozia Hamud

Group Art Unit
1646



☒ Responsive to communication(s) filed on Jan 31, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 37-57 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 37-57 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The request filed on 01/31/2000 in Paper No.12, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/142,043 is acceptable and a CPA has been established. An action on the CPA follows.

2. Claims 37-57 are pending and under consideration by the Examiner.

Specification

2a. The specification is objected to for reasons of record set forth on page 2 of the office action mailed on 07/29/99 in Paper No:11.

2b. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required. This objection to the specification is maintained for reasons of record set forth on page 2 of the office action mailed on 07/29/99, in Paper No:11.

Claim Rejections

Claims 37, 43, 48, 51, 54 and 57 are objected to for reasons of record set forth on pages 2-3 of the office action mailed on 07/29/99, in Paper No:11.

Claim rejections-Double patenting

Non-statutory double patenting rejection (obviousness-type)

The rejection of claims 37, 51 and 57 under the judicially created doctrine of obviousness-type double patenting is maintained for reasons of record set forth on pages 3-4 of the office action mailed on 07/29/99, in Paper No:11.

Claim Rejections - 35 U.S.C. § 112

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3. The rejection of claims 37-57 under 35 U.S.C. 112, first paragraph is maintained for reasons of record set forth on pages 5-10 of the office action mailed on 07/29/99, in Paper No:11.

4. The rejection of claims 37-57 under 35 U.S.C. 112, second paragraph is maintained for reasons of record set forth on pages 10-12 of the office action mailed on 07/29/99, in Paper No:11.

5. The rejection of claims 37, 39 and 51-57 under 35 U.S.C. 102(b) as being anticipated by Fearon et al, is maintained for reasons of record set forth on pages 12-13 of the office action mailed on 07/29/99, in Paper No:11.

6. The rejection of claims 48-50 under 35 U.S.C. 103 as being unpatentable over Fearon et al in view of Capon et al, is maintained for reasons of record set forth on pages 14-15 of the office action mailed on 07/29/99, in Paper No:11.

New rejections:

Claim Rejections - 35 U.S.C. § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7a. Claims 54-56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 54-56 recite "a polynucleotide encoding....." which encompasses the polynucleotide as it occurs in nature. However, since Applicants do not intend to claim a naturally occurring product amendment of the claims to show the hand of man would obviate this rejection. It is suggested that claims 54-56 be amended to recite "an isolated polynucleotide encoding". Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

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8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 8a. Claims 54-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 54 recites "a polynucleotide encoding an SCR3-derived polypeptide having 6 to 23 amino acid residues and comprising at least a portion of SEQ ID NO:1...", however, it is unclear, if the polynucleotide encoding the SCR3-derived polypeptide also comprises at least a portion of SEQ ID NO:1, or if the SCR3-derived polypeptide also comprises at least a portion of SEQ ID NO:1. Appropriate clarification is required.

Claims 55-56 are also vague and indefinite insofar as they depend on claim 54 for the limitation set forth directly above.

Conclusion

9. No claim is allowed.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia Hamud whose telephone number is (703) 308-8896. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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Fozia Hamud
Patent Examiner
Art Unit 1646
April 25, 2000

Prema Mertz
PREMA MERTZ
PRIMARY EXAMINER